

MAR 04 2008

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FACSIMILE TRANSMITTAL SHEET

TO:	FROM:
Special Programs Examiner Henry Yuen	Samuel S. Broda
COMPANY:	DATE:
USPTO	MARCH 4, 2008
FAX NUMBER:	TOTAL NO. OF PAGES INCLUDING COVER:
(571) 273-4856	9
PHONE NUMBER:	SENDER'S REFERENCE NUMBER:
	50269-0562
RE:	U.S. SERIAL NUMBER:
	10/671,026

URGENT FOR REVIEW PLEASE COMMENT PLEASE REPLY PLEASE RECYCLE

NOTES/COMMENTS:

SPRE Yuen,
 Please direct this petition to the appropriate
 person if you are not the deciding official.

Please contact me at 408.414.1239
 should you have any questions.

Thank you very much for your consideration
 of this matter.

Samuel Broda

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MAR 04 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Confirmation No.: 7849

Bruce Karsh et al.

Group Art Unit No.: 3714

Serial No.: 10/671,026

Examiner: Frisby, Kesha

Filed: September 24, 2003

For: VISIBLY DISTINGUISHING PORTIONS
OF COMPOUND WORDS

Technology Center 3700 (attention: Henry Yuen, Special Programs Examiner)
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

**PETITION FOR RESET OF PERIOD FOR REPLY DUE TO LATE
RECEIPT OF OFFICE ACTION**

Sir:

This petition relates to a previous petition to withdraw abandonment for the above-identified application (the "Application"). This petition is based on the following facts:

1. The correspondence address for the Application is: Hickman Palermo Truong & Becker, LLP, 2055 Gateway Place, Suite 550, San Jose, CA 95110-1089, the address of the attorneys of record for this Application (the "Firm").
2. On September 21, 2007, a Decision on Petition was mailed to the correspondence address for the above-identified application, the Decision granting a withdrawal of abandonment.
3. This Decision was received at the correspondence address on September 27, 2007 and docketed by the Firm on that date. See Attachment, Copy of Received Decision.

Docket No. 50269-0562

4. The Decision at page 3 states that "the Office action of record is to be remailed with a new shortened statutory period of three months beginning from the date of remailing of the Office action."
5. On February 20, 2008, Applicants discovered the existence of an Office action corresponding to the Decision, and notified the Firm via electronic mail.
6. The face of the Office action indicates a mailing date of 09/21/2007, and thus has a reply period ending on 03/21/2008.
7. As of the date of filing this petition, no mailed Office action has been received by the Firm at the correspondence address.

Request for Reset of Period

Based on the facts above, Applicants petition for reset of period. This type of petition is discussed at MPEP Section 710.06 (8th Ed. Rev. 6, Sept. 2007) under Roman numeral I. at page 700-169. This section states:

I. PETITIONS TO RESET A PERIOD FOR REPLY DUE TO LATE RECEIPT OF AN OFFICE ACTION

The Office will grant a petition to restart the previously set period for reply to an Office action to run from the date of receipt of the Office action at the correspondence address when the following criteria are met:

- (A) the petition is filed within 2 weeks of the date of receipt of the Office action at the correspondence address;
- (B) a substantial portion of the set reply period had elapsed on the date of receipt (e.g., at least 1 month of a 2- or 3-month reply period had elapsed); and
- (C) the petition includes (1) evidence showing the date of receipt of the Office action at the correspondence address (e.g., a copy of the Office action having the date of receipt of the Office action at the correspondence address stamped thereon, a copy of the envelope (which contained the Office action) having the date of receipt of the Office action at the correspondence address stamped thereon, etc.), and (2) a statement setting forth the date of receipt of the Office action at the correspondence address and explaining how the evidence being presented establishes the date of receipt of the Office action at the correspondence address.

Docket No. 50269-0562

It is believed that this petition satisfies the requirements listed above, as:

- (A) this petition is filed within 2 weeks of discovery of the existence of the Office action (as explained above, no "receipt" of the Office action has yet occurred);
- (B) a substantial portion of the set reply period has elapsed on the date of discovery (over 5 months of the reply period had elapsed on the date of discovery); and
- (C) this petition includes evidence of the docketing of the Office action once discovered, and includes a statement explaining this discovery.

Accordingly, Applicants respectfully request reset of the period for reply, and remailing of the Office action. It is believed that no fee for this petition is due; however, if any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any charge applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER
LLP

Dated: March 4, 2008

/Samuel S. Broda #54802

Samuel S. Broda
Reg. No. 54,802

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,026	09/24/2003	Bruce Karsh	50269-0562	7849
73066	7590	09/21/2007	EXAMINER	
Hickman Palmero Truong & Becker LLP/ Yahoo! Inc. 2055 Gateway Place Suite 550 San Jose, CA 95110-1089			FRISBY, KESHA	
SEP 27 2007			ART UNIT	PAPER NUMBER
			3714	
			MAIL DATE	DELIVERY MODE
			09/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DOCKETED
DATES:
9/27/07 3c

BASE 10
2003 ENT

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HICKMAN PAPERMO TRUONG & BECKER, LLP/
 Yahoo! Inc.
 2055 Gateway Place
 Suite 550
 San Jose, CA 95110-1089

8/21/07

In re Application of:
 Karsh, Bruce, et al.
 Serial No.: 10/671,026
 Filed: September 24, 2003
 Docket: 50269-0562

DECISION ON PETITION

Title: VISIBLY DISTINGUISHING PORTIONS
 OF COMPOUND WORDS

This is a decision on the petition filed on January 10, 2007 under 37 CFR § 1.181.
 Petitioner requests withdrawal of abandonment.

The petition is granted.

Background

Applicants submitted an application for patent on September 24, 2003. The application included, *inter alia*, a declaration under 37 CFR § 1.63 and a Utility Patent Application Transmittal form. The declaration provides the following correspondence address:

HICKMAN PAPERMO TRUONG & BECKER, LLP
 1600 Willow Street
 San Jose, California 95125-5106

The transmittal includes a Customer Number, 29989. A review of the Table of Contents of the file indicates that a notice of the association of this customer number to 1600 Willow Street was to be communicated by the U.S.P.T.O. (Office) via an Office form dated on the Contents line December 23, 2004 and listed on the Contents as "Change of Address". However, there is no date stamp on the form to indicate it was actually mailed to applicants' legal representative. Another line on the Contents with "Change of Address" and dated January 11, 2005 includes the same Office form on a second page of the line with "12-23-04" handwritten on it but this also does not evidence a formal mailing from the Office.

Application Serial No. 10/671,026
Decision on Petition

An Office action by the assigned examiner was mailed May 09, 2006 but was returned to the Office as undelivered on May 19, 2006. Page 37 of the contents of the return mailing includes a copy of the envelope which has a label presumably from the U.S. Postal Service and which states:

FORWARD TIME EXP RTN TO SEND
HICKMAN PAPERMO TRUONG & BECKER, LLP
2055 OLTEWAY PL STE 550
SAN JOSE, CA 95110-1083

On August 22, 2006, applicants filed a status inquiry with the new address but did not provide the Customer Number and a change of address. However, on December 04, 2006 a Power of Attorney was filed which included the Custom Number. The NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY (comprising page 2 of the Contents line set forth as "Communication-Re: Power of Attorney (PTOL-308)") was mailed December 12, 2006 to the new address. Since the Office action had been mailed May 09, 2006, the application is technically abandoned. On January 10, 2007, the petition to which this decision is based was filed. It is to be noted that a paper was filed August 10, 2007 associating the file with a new Customer Number (73066) and changing the address to:

HICKMAN PAPERMO TRUONG & BECKER, LLP/
Yahoo! Inc.
2055 Gateway Place
Suite 550
San Jose, CA 95110-1089

This address is now in the Office PALM records along with the new Customer Number as the correspondence address and is the address to which this decision is mailed.

Discussion

Along with the petition were included several additional papers. One is "Request for Customer Number Data Change" (Form PTO/SB/124A). There is no evidence of when it was filed but is dated December 17, 2004 as to when it was signed by one of applicants' legal representatives, Edward A. Becker (Registration No. 37,777) and includes the address change:

HICKMAN PAPERMO TRUONG & BECKER, LLP/
2055 Gateway Place, Suite 550
San Jose, California 95110

A facsimile transmittal sheet is also included with the Customer Number 29989. It includes a typed date of December 17, 2004 but was corrected by hand to change "17" to -- 22 --. It further includes that it was being sent to the Electronic Business Center of the

Application Serial No. 10/671,026
Decision on Petition

U.S. Patent & Trademark Office. There is no Certificate of Facsimile on either paper but Petitioner included a TRANSMISSION VERIFICATION REPO dated December 17, 2004 and a second similar paper but dated December 22, 2004. A copy of an Auto-Reply Facsimile Transmission paper from the Office by facsimile transmission and dated December 17, 2004 is also included in the petition. This paper verifies a Customer Number Data Change for number 29989.

The Auto-Reply Facsimile Transmission paper dated December 17, 2004 is considered evidence that applicants filed a proper change of address that was not entered. For unknown reasons the 37 CFR §1.63 declaration and accompanying transmittal on September 23, 2004 were not associated between the application serial number and the Customer Number. Because of this, it appears the change of address was not timely made by the Office at no fault of the applicants. Subsequently, the examiner's Office action was sent to the wrong address.

MPEP § 707.13 Returned Office Action, states in part:

Office actions are sometimes returned to the Office because the United States Postal Service has not been able to deliver them. **>Upon receipt of the returned Office action, the Technology Center (TC) technical support staff will check the application file record to ensure that the Office action was mailed to the correct correspondence address. If the Office action was not mailed to the correct correspondence address, it should be stamped "remailed" with the remailing date and mailed to the correct correspondence address. The period running against the application begins with the date of remailing.

Decision

The history of the application along with the evidence submitted by Petitioner indicates that the applicants made a timely and proper address change. In view of this and in accordance with MPEP § 707.13, the Office action of record is to be remailed with a new shortened statutory period of three months beginning from the date of remailing of the Office action. The application is being forwarded to the appropriate staff for this remailing. The application is considered not abandoned and is withdrawn from abandonment to the degree it was considered technically abandoned.

PETITION GRANTED.

It is noted that the petitioner included a check in the amount of \$400.00 to cover any fees for the petition though seeking relief under 37 CFR § 1.181. The petition was treated under 37 CFR § 1.181 which does not require a fee. Petitioner may request a refund in accordance with 37 CFR § 1.26. See MPEP 607.02.

Application Serial No. 10/671,026
Decision on Petition

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Programs Examiner, at (571) 272-4514.

Karen M. Young
Karen M. Young, Director

Technology Center 3700